



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Mailed : OCT - 8 2003

VJ
Paper Number 8

In re Application of : DECISION
Bank et al. : ON PETITION
Serial No.: 09/995,158 :
Filed : November 27, 2001 :
For: Structural Reinforcement :
Using Composite Strips :

This is a decision on a petition under 37 CFR 1.144 filed August 7, 2003 requesting a review of a restriction requirement as set forth in the Office action mailed April 9, 2003 and made final in the Office action mailed July 17, 2003.

That restriction requirement involved two groups as follows: Group I, claims 1-13, 19 and 20, drawn to an elongated structural reinforcing strip and a reinforced structure and Group II, claims 14-18, drawn to a method of reinforcing a structure.

It is noted that in a restriction requirement, the initial burden is on the Office to establish a *prima facie* case that (a) the claimed inventions are independent or distinct and (b) there would be a serious or undue burden on the examiner if restriction were not required. See MPEP 803.

With respect to (a) above, the examiner's basis for the restriction was Process of making and Product made (MPEP 806.05(f)). And, with respect to (b) above, it was indicated that the inventions had acquired a separate status in the art as shown by their different classification. See page 2 of the action mailed April 29, 2003.

In a response filed April 24, 2003, the applicants elected the invention of Group I with traverse.

The applicants' principal arguments are as follows:

(i) Separate classification does not "automatically provide evidence of a serious burden." The applicants point out that since there is "substantial overlap" between the limitations in claims 1 and 19 of Group I and claim 14 of Group II, there cannot be a serious burden. See page 3 of the petition.

(ii) The examiner failed to establish the independence or distinctness of the inventions because the examiner's rationale involving metallic fibers in a composite material (see the action mailed April 29, 2003) is "either inapposite or misunderstood." See page 4 of the petition.

(iii) Independent claims 1, 14 and 19 in the present application are linked i.e. they are not distinct. See page 4 of the petition.

With respect to applicants' argument (i), it is observed that claims 1, 14 and 19 cited by applicants as having a substantial overlap are, in fact, the independent claims, and just these, in both Groups. While applicants' argument is valid with respect to the independent claims, however, it is improper to exclude the dependent claims from the picture since these claims, in fact, form an inseparable part of the restriction requirement. Thus, attention is drawn to dependent claims 15-18 of non-elected Group II which incorporate various limitations such as a process for inserting fasteners by detonating a charge, prior formation of aperture, providing a compressible cushion and applying an adhesive between the strip and the surface of a structure. It is noted that these limitations are not to be found in any of the claims of the elected Group I. Because the applicants failed to address the limitations of the dependent claims, their argument relating to substantial overlap is incomplete as well as incorrect and is, therefore, unpersuasive. Hence, the applicants have not overcome the presumption that there would be a serious or undue burden to search and examine all the claims.

With respect to applicants' argument (ii), it is noted that under MPEP 806.05(f) the examiner is required to state that either the claimed process can be used to a materially different product or that a materially different process can yield the claimed product. However, the examiner is not obligated to provide documentation. In the action mailed April 24, 2003, the examiner set forth a materially different product, such as one involving metallic fibers, and in the action mailed July 17, 2003 the examiner described a materially different process such as one involving placing a strip upon a surface that already has fasteners. Applicants' argument that the examiner's rationale is "inapposite" (i.e. not pertinent) is based on the fact that the independent claims 1, 14 and 19 in the present application are, apparently, not limited to metallic fibers only. However, this argument is not persuasive because the applicants have ignored the dependent claims, such as claim 11 and 12, which specifically recite non-metallic fibers. In challenging the propriety of a restriction requirement, the applicants must address the totality of claims as encompassed by the restriction. Furthermore, the applicants have not addressed the examiner's position as set forth in the action mailed July 17, 2003.

With respect to applicants' argument (iii), as pointed out previously, the applicants' arguments are again improperly confined to the independent claims only as opposed to addressing all claims that are included in the restriction requirement. When the dependent claims, such as the ones cited above, are taken into account, it is evident that the claims are not linked contrary to applicants' position.

In view of the above discussion, having weighed both the examiner's position and the applicants' arguments, it is concluded that, on the balance, the restriction is proper.

Applicants are advised that, in the event that the elected product claims become allowable, then, provided that the non-elected process claims are amended so as to depend from or otherwise include all the limitations of the allowable product claim, then such process claims will be rejoined with the allowable product claims consistent with the requirement for rejoinder set forth in MPEP 821.04.

The petition is DENIED.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Intellectual Property Department
DEWITT ROSS & STEVENS S.C.
Firststar Financial Centre
8000 Excelsior Drive Suite 401
Madison WI 53717-1914